APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,802	08/24/2001	Sanjeev Dharap	YAHOO-01009US1	2167

23910 7590 03/08/2004	EXAMINER
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ART UNIT	PAPER NUMBER
2125	

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _15 December 2003_.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-4,6-23 and 25-28_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-4, 6-23 and 25-28_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

1.   Examiner acknowledges receipt of Applicant's response to the previous Office action. Claims 1-4, 6-23 and 25-28 remain pending in this application.

2.   In response to Applicant's argument, regarding the 35 U.S.C. §102(b) rejection of the claims, as being clearly anticipated by Applicant's admitted prior art, of the "Startac® organizer manufactured by Motorola, Inc." (pages 4-5 of the instant specification), and as supported by the "StarTAC clipOn Organizer, Synchronization, and TrueSync Desktop - User's Guide," published by Motorola, Inc., Examiner notes the following.

    a.   As presented in the previous Office action, Applicant admits that "Content information in the organizer is organized alphabetically by an alphabetical tag similar to a paper telephone address book, with each entry alphabetized in accordance with its rules of display in a "display name" field. The user may then select individual tabs using the control buttons which identify further levels of granularity in the alphabetization. For example, the opening screen lists a set of tabs, each tab containing three letters (e.g. "ABC," "DEF," etc.) representing the first letter of the last name of each contact. Selecting "ABC" yields another set of tabs with single letter entries (e.g. "A," "B," "C," etc.) and selecting "A" yields all entries presented with the letter "A." If a number of entries are provided for the letter A which exceeds the 10-line display of the device, the device will further sort entries into a pre-configured number of further levels of granularity, for example all entries between "A" and "AI," "AR" and "AT," etc. The organizer will sort, alphabetize, and granularize each letter of the alphabet depending on the number of contacts beginning with that letter. Selection of different controls occurs through use of one of the six control buttons on the device." As evidenced by the StarTAC ... User's Guide, this involves "mapping" each entry to a control input of the display device, as instantly claimed (i.e.; as shown on page 11 of the StarTAC ... User's Guide, the alphabetical letters N-S are "mapped" to the tabs of the displayed card lists, wherein selecting one of the tabs controls the display to show the subset of entries correlated to that particular tab, to allow for further selection by a user).

    b.   Applicant's argument, that the StarTac device does not teach having "each entry mapped to a control input in a display device," since the StarTac device is "described as using up and down selectors to move a cursor over a letter or a group of letters and then select that letter. Thus each entry is not mapped to a control input in a controller device" (page 7 of the instant response), is not

persuasive. Specifically, the StarTac User's Guide (page 58) shows the ability to "click" on a tab of a display, wherein these tabs are "mapped" to their displayed locations, such that the cursor can input the desired function of selecting the tab. The instantly claimed "each entry mapped to a control input in a display device" is deemed to "read-on" such mapped tabs of the StarTac device.

c.   Applicant's argument, that the StarTac device "need not determine whether an alphabetized list exceeds the maximum list length" (page 8 of the instant response), is not persuasive. Applicant has previously admitted that the StarTac device does specifically perform this function, since Applicant has admitted in the instant specification that "if a number of entries are provided for the letter A which exceeds the 10-line display of the device, the device will further sort entries into a pre-configured number of further levels of granularity, for example all entries between "A" and "AI," "AR" and "AT," etc. The organizer will sort, alphabetize, and granularize each letter of the alphabet depending on the number of contacts beginning with that letter," as noted above.

d.   Hence, claims 1-4, 6-23 and 25-28 stand rejected under 35 U.S.C. §102(b), as being clearly anticipated by Applicant's admitted prior art, of the "Startac® organizer manufactured by Motorola, Inc." (pages 4-5 of the instant specification), and as supported by the "StarTAC clipOn Organizer, Synchronization, and TrueSync Desktop - User's Guide," published by Motorola, Inc.

3.   In response to Applicant's argument, regarding the 35 U.S.C. §102(a) rejection of the claims, as being clearly anticipated by Saarinen et al. (EP-0915604), Examiner notes the following.

a.   As presented in the previous Office action, Saarinen et al. teach a "method of searching an electronic phonebook of a cellular phone, where the phonebook contains a multiplicity of names each being made up of one or more alphanumeric characters. The method comprises defining a search template by selecting a letter from a displayed list of the alphabet. The set of distinct data strings, present at the beginning of stored names, which commence with said template and which differ from one another by only their final character, are then identified. The user then selects one of said set of data strings as a new search template. If the number of names matching the new search template is less than some predefined number, then those names are displayed. If not, then the process is repeated using the new extended template" (the abstract). As shown in Figure 4, with accompanying text, list entries are "mapped" to control elements of the display, for selection by a user.

b.   As per claims 1-4, 6-10, 21-23 and 25-28, Applicant's argument, that Saarinen et al. do not teach having "each entry mapped to a control input in a display device," since Saarinen et al. describe "using up and down selectors to move a cursor over a letter or a group of letters and then select that letter. Thus each entry is not mapped to a control input in a controller device" (page 7 of the instant response), is deemed to be persuasive.

c.   As per claims 11-20, Applicant's argument, that Saarinen et al. "need not determine whether an alphabetized list exceeds the maximum list length" (page 8 of the instant response), is not persuasive. As noted above, Saarinen et al. specifically teach that "if the number of names matching the new search template is less than some predefined number, then those names are displayed. If not, then the process is repeated using the new extended template."

d.   Hence, the rejection of claims 1-4, 6-10, 21-23 and 25-28, under 35 U.S.C. §102(a), as being clearly anticipated by Saarinen et al. (EP-0915604), is withdrawn, while claims 11-20 stand rejected under 35 U.S.C. §102(a), as being clearly anticipated by Saarinen et al. (EP-0915604).

4.   In response to Applicant's argument, regarding the 35 U.S.C. §102(e) rejection of the claims, as being clearly anticipated by Bodnar (U.S. Patent No. 6,417,874), Examiner notes the following.

a.   Applicant's argument, that Bodnar does not teach having "each entry mapped to a control input in a display device," since Bodnar describes "using up and down selectors to move a cursor over a letter or a group of letters and then select that letter. Thus each entry is not mapped to a control input in a controller device" (page 7 of the instant response), is not persuasive. Bodnar specifically teaches that "the user interface implements a 'single-click' style of button operation, so that users can associate each button with a particular task for a given program context" (see the abstract). Also, the tabs shown in Figs. 7A-E, for example, are "mapped" to the display, only awaiting the cursor being placed over them. The association of these tabs to specific locations of the bit map of the display does not disappear simply because one of the tabs is highlighted.

b.   Applicant's argument, that Bodnar "need not determine whether an alphabetized list exceeds the maximum list length" (page 8 of the instant response), is not persuasive. Bodnar specifically shows, in Figs. 8A-F, that "the method is, ... driven in part by the number of lines

supported by the display" (col. 4, line 55 - col. 5, line 11; col. 11, line 60 - col. 12, line 21; col. 13, line 10 - col. 14, line 21).

      c.   Hence, claims 1-4, 6-23 and 25-28 stand rejected under 35 U.S.C. §102(e), as being clearly anticipated by Bodnar (U.S. Patent No. 6,417,874).

5.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR §1.136(a).

      A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria N. Von Buhr whose telephone number is 703-305-3837. The examiner can normally be reached on M-F (9am-5pm).

      If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on 703-308-0538. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

      Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maria N. Von Buhr
Primary Patent Examiner
Art Unit 2125